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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Russell E. Evans

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30764

7590

09/28/2004

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EXAMINER

FINEMAN, LEE A

ART UNIT

PAPER NUMBER

2872

DATE MAILED: 09/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 09/804,785	Applicant(s) EVANS ET AL.	
	Examiner Lee Fineman	Art Unit 2872	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

### Period for Reply

**A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.**

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 19 July 2004.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-12 and 32-42 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 and 32-42 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

This Office Action is in response to an amendment filed 19 July 2004 in which claims 1, 11-12 and 32 were amended and claims 39-42 were added. Claims 1-12 and 32-42 are pending.

#### *Double Patenting*

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1, 2 and 12 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 2 and 8 of U.S. Patent No. 6,413,641 and claims 1 and 3 of U.S. Patent No. 6,585,373. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the instant application are an obvious variation of the claims of U.S. Patent No. 6,413,641 or U.S. Patent No. 6,585,373. The polarizer in each of the patents must have a side, which can be called the "first side," that is optically bonded to a bonding surface of optical construct.

NOTE: Applicant stated in the remarks (page 6) that a Terminal Disclaimer was accompanying the amendment. However the office did not receive a Terminal Disclaimer. Please submit/resubmit the Terminal Disclaimer with the next action.

*Claim Rejections - 35 USC § 102*

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1, 3-5, 11-12, 32-39 and 41 are rejected under 35 U.S.C. 102(e) as being Smith by U.S. Patent No. 6,096,425.

Regarding claims 1, 3-4, 32, 38-39 and 41, Smith discloses an optical-quality polarized part (fig. 1) comprising a solid, unitary optical construct (1, 2, 4 and 5) having a bonding surface (fig. 1), including a front bonding surface (at 2, next to 3) and an opposing rear surface (at 4, next to 3) and comprising a high impact polyurethane-based optical material (2 and 4, column 3, lines 22-23 and 34-36); a polarizer (3), which is a wafer (fig. 1) comprising cellulose triacetate (column 3, lines 7-9), having a first side (next to 2) and an opposing side (next to 4) where in the first side and second side of the polarizer are integrally bonded to the optical construct across the entire bonding surface thereof or front bonding surface thereof, in a prescribed place thereon (fig. 1), which is also within the optical construct; and wherein the polarizer comprises at least one layer supporting a polyvinyl alcohol film (column 3, lines 7-9).

Regarding claim 5, Smith further discloses wherein the optical construct is a lens substrate (column 1, line 10 (sunglasses)).

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Regarding claims 11 and 12, Smith further discloses comprising a hard coating (column 3, lines 16-18), wherein the hard coating is integrally bonded to the optical construct and therefore the sides of the polarizer within it.

Regarding claims 33 and 35, Smith further discloses wherein the polarizer is treated and bonded to the optical construct after the optical construct has been formed (column 4, lines 9-14).

Regarding claim 34, Smith further discloses wherein the optical construct has a front surface and an opposing rear surface (fig. 1) and wherein the polarizer is bonded to the optical construct near the front surface (fig. 1).

Regarding claims 36 and 37, Smith further discloses wherein the polarizer has a thickness of less than 0.2 mm (column 3, lines 47-48).

### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 2, 40 and 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith in view of Kausch et al., U.S. Patent No. 6,113,811.

Smith discloses the claimed invention except for the polarizer comprising a polyethylene terephthalate film. Kausch et al. teaches a polarizer comprising a polyethylene terephthalate film

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(column 10, lines 52-57). It would have been obvious to one having ordinary skill in the art at the time the invention was made to use the polarizer of Kausch in the optical-quality polarized part of Smith to reduce glare (Kausch, column 1, line 13).

7. Claims 6-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith in view of Slagel, US Patent No. 6,127,505.

Smith discloses the claimed invention except for wherein the high impact polyurethane-based optical material is comprising a polyurethane prepolymer including a dye or colorant; wherein the prepolymer comprises up to about 12 molar percent of trimethylol propane; and wherein the high impact polyurethane-based optical material comprises a reaction product of (a) a polyurethane prepolymer prepared by reaction of a methylenebis (cyclohexyl isocyanate) with an OH-containing intermediate having a weight average molecular weight between about 500 and about 1,200 selected from the group consisting of polyester glycols, polyether glycols, and mixtures thereof in an equivalent ratio of 2.5 to 4.0 NCO/1.0 OH and (b) an aromatic diamine curing agent in an equivalent ratio of about .9 to 1.1  $\text{NH}_2$ /1.0 NCO. Slagel teaches an optically clear high impact polyurethane-based optical material (column 2, lines 4-10) comprising a polyurethane prepolymer including a dye or colorant (column 6, lines 7-10, table 1) wherein the prepolymer comprises up to about 12 molar percent of trimethylol propane (column 5, line 65-column 6 line 5), and wherein the high impact polyurethane-based optical material comprises a reaction product of (a) a polyurethane prepolymer prepared by reaction of a methylenebis (cyclohexyl isocyanate) with an OH-containing intermediate having a weight average molecular weight between about 500 and about 1,200 selected from the group consisting of polyester

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glycols, polyether glycols, and mixtures thereof in an equivalent ratio of 2.5 to 4.0 NCO/1.0 OH and (b) an aromatic diamine curing agent in an equivalent ratio of about .9 to 1.1 NH<sub>2</sub>/1.0 NCO (column 1, line 59-column 2, line 3 and column 3, lines 16-21). It would have been obvious to one having ordinary skill in the art at the time the invention was made to use the polyurethane of Slagel in the optical construct of Smith to provide a optical product with high heat distortion temperatures and reduced cost (column 2, lines 11-18, Slagel).

### ***Response to Arguments***

8. Applicant's arguments filed 19 July 2004 have been fully considered but they are not persuasive.

Applicant argues that Smith does not disclose an optical construct that is solid and unitary because it has layers. The examiner respectfully disagrees. As there is no special definition attached to "solid" and "unitary" in the instant application, the examiner used the definitions presented in Merriam-Webster's Colligate Dictionary Tenth Edition. Solid is defined as "of uniformly close and coherent texture" and "possessing or characterized by the properties of a solid: neither gaseous nor liquid." Clearly, the optical construct of Smith is solid in at least so far as it is not gaseous or liquid and is of uniformly close and coherent texture as a lens. Unitary is defined as "of or relating to a unit" or "having the character of a unit." Again, clearly the layered optical construct of Smith can be considered a single unit and therefore is unitary. In fact, the examiner would like to point out that when the polarizer is within the optical construct as in claim 39, by the applicant's argument, the optical construct of claim 39 would not be solid and unitary which is clearly not the case.

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The applicant also argues that the polyurethane adhesive film layers (2, 4) are insufficiently sized to constitute an optical construct by themselves. The examiner would like to remind the applicant that these layers were not identified by themselves as the optical construct but together with 1 and 5. However, the examiner would also like to point out that there is nothing in the specification or claims which details that an optical construct must be able to support itself.

9. It is noted by the Examiner that the claim objection made in the previous Office Action has been withdrawn due to amendment by the Applicant.

### *Conclusion*

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.



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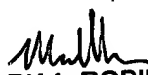
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lee Fineman whose telephone number is (571) 272-2313. The examiner can normally be reached on Monday - Friday 7:30 - 4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Drew Dunn can be reached on (571) 272-2312. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



LAF  
September 21, 2004

  
**MARK A. ROBINSON**  
**PRIMARY EXAMINER**